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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,349	08/16/2001	Byung Ju Dan	2080-3-33	2633

35884 7590 03/24/2006

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,349	DAN ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 8/16/2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6/9/2003.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "20" in figure 10 has been used to designate both the Nabisco bar-coded coupon and the personal computer. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 100, 100-1, 100-2, 100-3, 100-4, and ST7. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because it exceeds the 150 word limit. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Referring to claims 1-3, 5, 7-9, 11, 12, 14-16, and 19, the claims recite the limitation "learning/growing". It is unclear if the limitation refers to "learning", "growing", "learning and growing" or "learning or growing".

Referring to claims 2, 3, 5, 6, 12, 13, 19, 21-23, and 26, the phrase "such as" renders these claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Referring to claim 13, the phrase "that is" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Referring to claim 5, the claim recites the limitation "totally controlling". It is unclear as to how this is different from the controlling that is recited in other claims. Also, since other claims recite controlling steps and features, how can one piece of hardware or software "totally control" the toy?

Referring to claim 18, this claim recites the limitations "the CCD camera", "the barcode reader", and "the user computer". There is insufficient antecedent basis for these limitations in the claim.

Referring to claim 24, this claim recites the limitation "the tastes". There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 19, this claim recites the limitation "abstracting goods code". It is unclear as to how goods code can be abstracted. Examiner takes the step of abstracting to read as "extracting".

Referring to claims 1-34, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The claims appear to be written to treat hardware and software as living subject matter. Applicant needs to specify what structure and steps are virtual or simulated, and which structure and steps exist in the real world. Some examples are as follows:

- Web servers don't memorize. They can store information. Memorization is a living trait.
- A toy can't have "tastes", however, it can store preferences. These tastes appear to be virtual tastes.
- How is the toy physically grown? Is this growth accomplished virtually?
- Intellect is a human trait. A toy can't grow intellectually. It can store information and reference that information consistently as if it has simulated the act of learning.

These were only a few examples. Applicant must go through the claims and clearly specify the different between "real world" and simulation. All claims must be addressed and corrected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to non-statutory subject matter. The claiming of living subject matter is non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1-8, 12-16, 19-23, 25, 26, 28-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dureau (U.S. Patent No. 6,513,160) in view of Hofmann (U.S. Patent No. 6,757,796).**

Regarding claims 1-3, 7, 13, 19, 25, 33, and 34, Dureau teaches a toy (genie) that expresses desires for learning (it wants to watch certain programming, which is taken to read on learning) (Abstract, Sentence 2), eating, and playing (Column 8, Lines 17-21). The programming the genie wants to watch can be advertising programming (taken to read on advertising banner) (Column 3, Lines 55-57) and the genie will be unsatisfied unless that programming is watched (Column 6, Lines 60-62). The programming comes from a broadcast station, and the programming contains unique identification codes (also stored at the broadcast station) (Column 8, Lines 63-66). This is taken to read on the banner database table and the goods information database table. Any advertisements not registered with the genie are taken to be unregistered goods. Dureau doesn't teach a web server interacting with the toy. Hofmann teaches the streaming of video over the internet from web pages to personal computers (Column 1, Lines 28-32). It would have been obvious to one having ordinary skill in the art at the

time the invention was made to have the genie connect to a television broadcast or a computer broadcast. This would make the invention accessible to more users.

Regarding claims 4 and 20, neither Dureau nor Hofmann teaches the updating of advertisements or programming. It would have been obvious to one having ordinary skill in the art at the time the invention was made that programming would need to be updates continuously. This would give more advertisers a chance to advertise.

Regarding claims 5 and 6, Dureau teaches that the genie outputs signals in accordance with desires (Column 6, Lines 60-67), recognizes and judges programming information (since the genie is programmed to desire certain programming, the system inherently has a way of deciphering which programming is good for the genie) (Column 6, Lines 60-62), and changes control patterns based on programming chosen to be watched by the user (the genie becomes healthier or unhealthier) (Column 6, Lines 60-67 and Column 7, Lines 1-5).

Regarding claims 8 and 16, Dureau teaches the genie as hiding in a commercial (Column 7, Lines 15-17). Neither Dureau nor Hofmann specify the genie as mimicking motion, voice, or music from the advertising. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the genie to imitate advertising motion. This would help the genie fit into the advertisement and provide for a more challenging game.

Regarding claim 12, Dureau teaches the user as being a targeted user (Column 6, Lines 33-36). Since the user is targeted, there must inherently be a storage for user information. Thus, Dureau teaches a user database table for storing information. This

also reads on a manual database for storing information (nothing after "such as" was positively claimed).

Regarding claims 14 and 15, Dureau teaches the expressing of desires (Column 8, Lines 17-21, and Abstract, Sentence 2), the outputting of those desires to the broadcast station (request to connect), the choosing (selecting which channel to watch) and downloading of advertisement programming to satisfy the genie, and the growing of the toy due to the advertisement programming (Column 6, Lines 60-67 and Column 7, Lines 1-5). Dureau doesn't teach a web server interacting with the toy. Hofmann teaches the streaming of video over the internet from web pages to personal computers (Column 1, Lines 28-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the genie connect to a television broadcast or a computer broadcast. This would make the invention accessible to more users. The steps of asking of the user if they would like to select an advertisement and waiting until they choose the advertisement are inherent (the health of the genie is equivalent to asking).

Regarding claims 21-23, neither Dureau nor Hofmann specifies the type of advertising programming the user can watch. Official notice is taken that food advertisements, learning institution advertisements, and entertainment advertisements are all old and well-known forms of advertising. It would have been obvious to one having ordinary skill in the art at the time the invention was made to advertise any form of goods. This would allow more advertising revenue to be generated.

Regarding claim 26, Dureau teaches advertisements as being downloaded from a broadcast station. The commercial advertisements must inherently be stored on a storing medium at the source, and for the genie to read the programming data, the advertisements must inherently be sent to some sort of storing medium of the genie.

Regarding claims 28 and 29, Dureau teaches the desires of the toy as being generated by both the toy (decides when it desires advertisements, grows unhealthy when it hasn't watched its programming) (Column 6, Lines 60-62) and the database (decides which advertisement programming the genie desires to watch) (Column 8, Lines 63-66).

Regarding claim 30, Dureau teaches the genie as growing unhealthy if certain programming isn't watched (Column 6, Lines 60-67 and Column 7, Lines 1-5). Dureau doesn't teach desires of the genie as being generated through letters or sound forms. Since television comprises audio as well as video, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the genie to express its desires in many different ways. This would allow blind and deaf people to realize the genie is in distress as well.

Regarding claim 31, Dureau teaches the genie as getting unhealthier and eventually dying if associated programming is not watched (Column 7, Lines 54-57). This shows different desire generation based on status of the genie.

Allowable Subject Matter

7. Claims 9-11, 17, 18, 24, 27, and 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to virtual pets and animated characters connectable to computer mediums:

U.S. Pub No. 2004/0176170 to Eck

U.S. Patent No. 6,088, 731 to Kiraly

http://web.archive.org/web/20000510133203/www.pfmagic.com/central/default.asp

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

JEFFREY D. CARLSON
PRIMARY EXAMINER